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In re Application of:  
ELLSWORTH, Michael, Aaron, et al.  
U.S. Application No.: 10/593,134  
Int'l Application No: PCT/IB2005/000610  
Int'l Filing Date: 04 March 2005  
Priority Date: 17 March 2004  
Atty Docket No.: PC32199A  
For: METHOD OF VACCINATION  
AGAINST TESTICULAR BVDV  
INFECTION

DECISION ON PETITION  
(37 CFR 1.137(b))

This decision is issued in response to applicants' petition for revival under 37 CFR 1.137(b), filed 12 December 2007. Applicant has paid the required petition fee.

**BACKGROUND**

On 04 March 2005, applicants filed international application PCT/IB2005/000610. The application claimed an earlier priority date of 17 March 2004, and it designated the United States. On 29 September 2005, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for filing the basic national fee was thirty months from the priority date, i.e., 18 September 2006 (17 September 2006 was a Sunday).

The published international application identified two applicant/inventors for the United States: Michael Aaron ELLSWORTH and Cassius McAllister TUCKER.

On 18 September 2006, applicants filed a Transmittal Letter requesting entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 14 March 2007, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification Of Missing Requirements" (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497, the surcharge for filing the oath or declaration later than thirty months after the priority date, and sequence listing materials were required.

On 14 June 2007, applicants filed a response to the Notification Of Missing Requirements (with required extension fee) that included an executed declaration, the required surcharge payment, and a statement that the present application did not include a nucleotide or amino acid sequence listing.

On 17 September 2007, the DO/EO/US mailed a "Notification Of Defective Response" (Form PCT/DO/EO/916) indicating that the declaration filed 14 June 2007 was defective because: (1) the declaration appeared to be a compilation of multiple declaration documents; and (2) the declaration included a third inventor, Maurice Daniel GIVENS, who was not listed on the international application.

Applicants did not file a response to the Notification Of Defective Response during the one-month response period. Accordingly, the present application became abandoned at midnight on 18 October 2007.

On 12 December 2007, applicants filed the petition for revival considered herein accompanied by, among other materials, a revised declaration.

### DISCUSSION

37 CFR 1.137(b) permits the filing of a petition to revive an abandoned application where the abandonment resulted from an unintentional delay. A grantable petition under this section must include: (1) the required reply, unless previously filed; (2) the petition fee required by law; (3) a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional;" and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c).<sup>1</sup>

With respect to item (1), the "required reply" is a proper response to the Notification Of Defective Response mailed 17 September 2007, that is, an oath or declaration acceptable under 37 CFR 1.497. Applicants' present petition includes a revised declaration that resolves the compilation defect present in the previously filed declaration. However, the second defect identified in the Notification Of Defective Response has not been corrected, that is, the revised declaration names and is executed by a third inventor, Maurice Daniel GIVENS, who is not an inventor of record herein. As discussed in MPEP section 1893.01(e) (emphasis added):

The inventorship of an international application entering the national stage under 35 U.S.C. 371 is that inventorship set forth in the international application, which includes any changes effected under PCT Rule 92*bis*. See 37 CFR 1.41(a)(4). Accordingly, **an oath or declaration that names an inventive entity different than that set forth in the international application will not be accepted for purposes of entering the U.S. national phase unless the requirements under 37 CFR 1.497(d) are satisfied.** These requirements include: (A) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;

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<sup>1</sup> Item (4) does not apply to the present application.

(B) the processing fee set forth in 37 CFR 1.17(i); and (C) the written consent of the assignee if an assignment has been executed by any of the original named inventors (see 37 CFR 3.73(b)).

The revised declaration is not accompanied by the materials required under 37 CFR 1.497(d) to correct the inventorship herein to include Maurice Daniel GIVENS. Accordingly, the revised declaration cannot, on the present record, be accepted under 37 CFR 1.497. Item (1) above is therefore not satisfied.<sup>2</sup>

With respect to item (2), applicant has paid the required petition fee. Item (2) is therefore satisfied.

With respect to item (3), the petition includes the required statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional." Item (3) is therefore satisfied.

### CONCLUSION

Applicants' petition for revival under 37 CFR 1.137(b) is **DISMISSED** without prejudice for failure to satisfy all the requirements of a grantable petition.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any request for reconsideration should be entitled "Renewed Petition Under 37 CFR 1.137(b)" and it must include the materials required to complete the "required reply," that is, a grantable request under 37 CFR 1.497(d) to correct the inventorship herein to include Maurice Daniel GIVENS (so as to permit acceptance of the revised declaration filed 12 December 2007).

No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration



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<sup>2</sup> It is noted that the revised declaration is a form for use with an Application Data Sheet (ADS); however, applicants have not yet submitted an ADS containing such necessary information as the residence and mailing addresses of the inventors.